

REMARKS

Claim Rejections

Claims 1, 3-4, 7-12, 14-15, 18-22, 33, 35-36, 39-41, and 43 stand rejected as indefinite.

Claims 1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art (Specification 1:24 to 2:8), Bennett '178 and U.S. Patent No. 6,485,367 (Joshi).

Claims 4, 15, 36, and 44 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Mayeroff and Joshi.

Claims 10, 11, 21, and 22 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Walker and Joshi.

Claims Amendments

The claims have been amended to eliminate the indefiniteness rejections. It is respectfully submitted that the amended claims are directed to allowable subject matter.

Applicant's Invention Would Not Have Been Obvious

Three criteria must be met to establish obviousness. First, the prior art must provide one of ordinary skill in the art with a suggestion or motivation to modify or combine the teachings of the references relied upon in rejecting the claims. Second, the prior art must provide one of ordinary skill in the art with a reasonable expectation of success. Third, the prior art, either alone or in combination, must teach or suggest each and every limitation of the rejected claims. The teaching or suggestion to make the claimed invention, as well as the reasonable expectation of success, must come from the prior art and not from Applicant's disclosure. If any one of these criteria is not met, a case of obviousness is not established. Also, some articulated reasoning with rational underpinnings must be provided to support a *prima facie* case of obviousness.

The combination of references relied upon in rejecting Applicant's claimed invention does not result in that invention. Thus, a *prima facie* case of obviousness has not been made out.

Applicant's claimed invention, for instance, as called for by claim 1, requires that the controller is programmed to receive data relating to a request from a person made during the occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person. The controller is also programmed to make an automated selection from among a plurality of user-selectable options according to the

rules of a wagering game being played and according to a strategy to optimize the likelihood that the person will receive a value payout.

Joshi does not disclose these features of Applicant's claimed invention. In Joshi, the CPU of the gaming machine 10 is configured to make a recommendation to a player at the start of each game. The player is free to ignore the CPU's recommendation or follow his own play strategy. (Col. 4, lines 43-60; Col. 8, line 66 to Col. 9, line 17).

As conceded in the Office Action, Joshi "does not teach an automated selection feature (nor is it relied upon for such a teaching)." (Office Action, page 6). That is, as stated in the Office Action, "Joshi teaches the identification of selections due to an optimal strategy not the selection of these items...." (Id.).

The fact is that none of the cited references disclose a controller programmed to make an automated selection from among a plurality of user-selectable options in response to a request from a person and according to the rules of a wagering game being played and according to a strategy to optimize the likelihood that the person will receive a value payout.

The Admitted Prior Art relates to a display of a keno game including a button that could be actuated by a player to allow a controller to randomly select a plurality of numbers on behalf of the player. As noted, Joshi does not disclose an automated selection feature. Rather, Joshi discloses a system that makes a recommendation at the start of each game. A player is free to either ignore or accept the recommendation.

Joshi's system is thus the antithesis of a system which includes an automated selection in response to a player request, and according to the rules of the game and according to a strategy to optimize the likelihood of success. Thus, in this respect, Joshi teaches away from Applicant's claimed invention. As such, Applicant's claimed invention would not have been obvious.

Conclusion

In view of the forgoing, it is respectfully submitted that all of the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorney at (510) 663-1100.

The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 504480 (Order No. IGT1P530).

Respectfully submitted,
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